

Appl. No. 10/827,235
Amendment dated: February 8, 2005
Reply to OA of: November 9, 2004

REMARKS

Applicants have amended the claims to more particularly define the invention taking into consideration the outstanding Official Action. Claim 7 has been amended to clarify the subject matters thereof; and new claims 11 and 12 have been added. The amendments to the claims and the new claims are fully supported by the specification as originally filed and which includes the original claims.

Applicants most respectfully submit that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

Rejection of claims 7-10 under 35 U.S.C. 102 as being anticipated by or under 35 U.S.C. 103(a) as being unpatentable over prior art references

According to the invention as defined in the amended claim 7, a ceramic capacitor is manufactured, which includes ceramic green sheets composed of ceramic grains. Further, according to the ceramic capacitor obtained by the method of the present invention, a ratio A/B of an outer portion of the ceramic grains is greater than that of an inner portion thereof. This is a claim limitation which cannot be ignored from claim 7 and fully distinguishes over the prior art applied in the rejections.

In order to obtain this property, the method of the present invention utilizes silane coupler, e.g., tetraethoxysilane in example 1 of the specification. Since, when mixed with barium acetate, tetraethoxysilane disperses barium uniformly throughout the surface of TiO_4 , the method of the present invention can control precisely the ratio A/B. In specific, in accordance with the method of the present invention, Ba component is dissolved in a solvent, e.g., ethylene glycol in example 1; and the Ba component is fixed on the surface of TiO_4 through the use of the coupler, e.g., tetraethoxysilane in example 1 to thereby obtain a desired component ratio.

In contrast, none of the prior art references cited by the Examiner, including Nishiyama et al. (US 5,397,753), Masumiya et al. (US 6,628,502) and Satoh et al. (US

Appl. No. 10/827,235
Amendment dated: February 8, 2005
Reply to OA of: November 9, 2004

5,990,029), discloses or suggests that a ratio A/B of an outer portion of the ceramic grains is greater than that of an inner portion thereof. Those prior art references cannot obtain the positively recited feature of the present invention, since they produce a ceramic green sheet in a different way. Therefore, neither the Nishiyama et al or Masumiya et al reference anticipates the claimed invention and the rejections over these references should be withdrawn.

According to the prior art references, just like comparative example of the specification, additives, e.g., BaCO₃, are mixed, as powders, with the primary component. Since the prior art references do not use a coupler, A-site component, i.e., barium is not dispersed uniformly throughout the surface of TiO₄, thereby resulting in a variation of Ba distribution on the surface of TiO₄. Accordingly, the ratio A/B cannot be precisely controlled.

Applicants wish to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a

Appl. No. 10/827,235
Amendment dated: February 8, 2005
Reply to OA of: November 9, 2004

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence present by applicant and the citation of In re Soni for error in not considering evidence presented in the specification.

Since the prior art references lack the above positively recited feature of the presently claimed invention, and since there is no possible motivation to include the feature, it is respectfully submitted that the prior art references could have not suggested the claimed invention, and that the rejection under 35 U.S.C. 102 and 103(a) are therefore improper.

Further, it is also believed that the claims 8-12, directly or indirectly depending on claim 7, are allowable for the same reasons indicated with respect to claim 7, and further because of the additional features recited therein.

CONCLUSION

Applicants believe that this is a full and complete response to the Office Action. For the reasons discussed above, Applicants now respectfully submit that all of the pending claims are in complete condition for allowance. Accordingly, it is most

Appl. No. 10/827,235
Amendment dated: February 8, 2005
Reply to OA of: November 9, 2004

respectfully requested that the Examiner's rejections be withdrawn; and that claims 7-12 be allowed in their present form.


Should the Examiner require or consider it advisable that the specification, claims an/or drawings be amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case be passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

BACON & THOMAS, PLLC

By: 
Richard E. Fichter
Registration No. 26,382

625 Slaters Lane, 4th Fl.
Alexandria, Virginia 22314
Phone: (703) 683-0500
Facsimile: (703) 683-1080

REF:kdd
A01.wpd

February 8, 2005